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EXAMINER

KALINOWSKI, ALEXANDER G

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 06/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/487,932

Applicant(s)
Feidotin et al

Examiner
Alexander Kalinowski

Art Unit
3626



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 1, 2003
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Recent Statutory Changes to 35 U.S.C. § 102(e)

On November 2, 2002, President Bush signed the 21st Century Department of Justice Appropriations Authorization Act (H.R. 2215) (Pub. L. 107-273, 116 Stat. 1758 (2002)), which further amended 35 U.S.C. § 102(e), as revised by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)). The revised provisions in 35 U.S.C. § 102(e) are completely retroactive and effective immediately for all applications being examined or patents being reexamined. Until all of the Office's automated systems are updated to reflect the revised statute, citation to the revised statute in Office actions is provided by this attachment. This attachment also substitutes for any citation of the text of 35 U.S.C. § 102(e), if made, in the attached Office action.

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 prior to the amendment by the AIPA that forms the basis for the rejections under this section made in the attached Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

For more information on revised 35 U.S.C. § 102(e) visit the USPTO website at www.uspto.gov or call the Office of Patent Legal Administration at (703) 305-1622.

DETAILED ACTION

1. Claims 1-26 are presented for examination. Applicant filed affidavits under Rule 1.31 on 4/1/2003. The affidavits were effective to overcome the Parker reference but were ineffective to overcome the ParkStone, Menduno, and med-I-nets references. New grounds of rejection are established for claims 4-7 and 11 in light of Applicant's affidavit.

Response to Amendment

2. The affidavits filed on 4/1/2003 under 37 CFR 1.131 is sufficient to overcome the Parker reference.

3. The affidavits filed on 4/1/2003 under 37 CFR 1.131 has been considered but is ineffective to overcome the ParkStone, Menduno, and med-I-nets references.

4. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the ParkStone, Menduno, and med-I-nets references to either a constructive reduction to practice or an actual reduction to practice. The declaration of Dion Bergman establishes due diligence at best from 9/16/1999 to the filing date of the instant application. The declaration of Jeffrey Tangney does not establish due diligence from prior to July 1, 1999 to at least 9/16/1999 since the declaration only discloses two presentations given prior to July 1, 1999 but does not describe any evidence establishing due diligence from July 1, 1999 to at least 9/16/1999.

The declaration of Richard Feidotin fails to establish due diligence from at least July 1, 1999 to at least 9/16/1999 since the declaration does not describe any activity from July 30, 1999 - August 6, 1999 and between August 31, 1999 - September 7, 1999. Furthermore, the

declaration fails to describe any activity during the period from September 7, 1999 - September 15, 1999.

Finally, the declaration of Thomas Lee fails does not establish due diligence from at least July 1, 1999 to at least 9/16/1999 since the declaration does not disclose any activity from July 1, 1999 to at least 9/16/1999.

The affidavits do not establish due diligence from July 1, 1999 through at least 9/16/1999 and therefore the affidavits are ineffective with respect to the ParkStone, Menduno, and med-I-nets references.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 2, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over “ParkStone Introduces New Hand-Held, Electronic Point-of-Care Tool Based on Microsoft Windows”(hereinafter ParkStone) in view of Menduno, Michael, “Apothecary.now”(hereinafter Menduno).

As to claim 1, ParkStone discloses a method for distributing medical data to medical personnel (i.e. system provides essential assistance to physicians with drug formulary data)(see abstract), said method comprising the steps of:
storing medical data in a database (i.e. physicians' prescription and referral information server ... referral and clinical test database ... easy to use database software)(page 2); and
periodically communicating selected medical data between said database and an electronic device to establish a medical data distribution system (i.e. by being able to connect to the physicians offices via the Internet and/or modem on a daily basis, the PPARIS system is able to provide them with the most current insurance company rules)(page 2)

ParkStone does not explicitly disclose
a medical data distribution system subsidized by sponsoring entities.

However, Menduno discloses a medical data distribution system subsidized by sponsoring entities (i.e. insurers and hospitals have sponsored EDI services ... Microsoft and Dupont Life Sciences ... agreed to underwrite \$330 million in prepaid doctor subscriptions to Healthcon's Internet Service)(page 4). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include a medical data distribution system subsidized by sponsoring entities as disclosed by Menduno within the ParkStone method for the motivation of increasing access to doctors and health care consumers (page 4).

As to claim 2, ParkStone discloses a method according to claim 1, wherein said method further comprises the initial step of aggregating said medical data from multiple sources (i.e. PPARIS has the ability to provide physicians with accurate and near real time information on each

insurance company's continually changing regulations)(page 2).

As to claim 12, ParkStone discloses a computer readable memory storing executable instructions for execution by a computer system such that said computer system functions in a specified manner (i.e. PPARIS system ... using proprietary software that runs on a Windows CE platform)(see abstract) , said instructions comprising:

instructions for storing medical data in a database (i.e. physicians' prescription and referral information server ... referral and clinical test database ... easy to use database software)(page 2);
and

instructions for periodically communicating selected medical data between said database and an electronic device to establish a medical data distribution system (i.e. by being able to connect to the physicians offices via the Internet and/or modem on a daily basis, the PPARIS system is able to provide them with the most current insurance company rules)(page 2).

ParkStone does not explicitly disclose

a medical data distribution system subsidized by sponsoring entities.

However, Menduno discloses a medical data distribution system subsidized by sponsoring entities (i.e. insurers and hospitals have sponsored EDI services ... Microsoft and Dupont Life Sciences ... agreed to underwrite \$330 million in prepaid doctor subscriptions to Healtheon's Internet Service)(page 4). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include a medical data distribution system subsidized by sponsoring entities as disclosed by Menduno within the ParkStone method for the motivation of increasing access to doctors and health care consumers (page 4).

As to claim 13, ParkStone discloses a computer readable memory according to claim 12, further comprising instructions for aggregating said medical data from multiple sources (i.e. PPARIS has the ability to provide physicians with accurate and near real time information on each insurance company's continually changing regulations)(page 2).

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over ParkStone and Menduno as applied to claim 2 above, and further in view of Mayaud, Pat. No. 5,845,255.

As to claim 3, ParkStone does not explicitly disclose a method according to claim 2, wherein said aggregating step further comprises collecting medical data selected from a group consisting of formulary data and pharmacopeia data.

However, ParkStone discloses collecting medical data including formulary data (i.e. if a prescription formulary is changed or a new sub specialist is added to the provider panel, the PPARIS system enables the primary care provider to be aware of this new data ...)(page 2). Furthermore, Mayaud discloses collecting medical data from the group consisting of pharmacopeia data (i.e. test trials ... drug disclosure requirements as set forth by the FDA ... drug warnings and alerts ... cost benefit data ...adverse outcomes ... offer a selection of all known formulations of the drug selected)(col. 23, col. 24 and col. 26, lines 11-20). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include said aggregating step further comprises collecting medical data selected from a group consisting of formulary data and pharmacopeia data as disclosed by Mayaud within the ParkStone and Menduno combination for the motivation of enabling a physician to rapidly quantify prescription information with appropriate dosages that can be filled at a pharmacy (col. 26, lines 11-15).

8. Claims 4-5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over ParkStone and Menduno as applied to claim 1 above, and further in view of Carlson, Janet, "Turning on the cyberphysician"(hereinafter Carlson).

As to claim 4, ParkStone and Menduno do not explicitly disclose a method according to claim 1, wherein said method further comprises the step of selling sponsorship rights to said sponsoring entity, wherein said sponsorship rights at least partly fund said medical data distribution system.

However, Carlson discloses the step of selling sponsorship rights to said sponsoring entity, wherein said sponsorship rights at least partly fund said medical data distribution system (i.e. services provided by this sponsored network now include access to Medicine's Medline and Healthstat databases)(page 1, see abstract). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the step of selling sponsorship rights to said sponsoring entity, wherein said sponsorship rights at least partly fund said medical data distribution system as disclosed by Carlson within the ParkStone and Menduno combination for the motivation of providing access to a targeted audience including physicians (i.e. tap into cyberphysicians)(page 2, paragraph 2).

As to claim 5, ParkStone does not explicitly disclose a method according to claim 4, wherein said selling step comprises vending sponsorship rights to at least one sponsor selected from a group consisting of a pharmaceutical company; a pharmacy benefit management organization; a health care insurer; a pharmacy; a medical supplier; a medical publisher; a contract

research organization or a managed care organization.

However, Carlson discloses said selling step comprises vending sponsorship rights to at least one sponsor selected from a group consisting of a pharmaceutical company; a pharmacy benefit management organization; a health care insurer; a pharmacy; a medical supplier; a medical publisher; a contract research organization or a managed care organization (i.e. sponsorship roles for pharmaceutical companies include ...)(page 5, paragraph 3). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include said selling step comprises vending sponsorship rights to at least one sponsor selected from a group consisting of a pharmaceutical company; a pharmacy benefit management organization; a health care insurer; a pharmacy; a medical supplier; a medical publisher; a contract research organization or a managed care organization as disclosed by Carlson within the ParkStone method for the motivation of providing access to a targeted audience including physicians (i.e. tap into cyberphysicians)(page 2, paragraph 2).

9. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over ParkStone and Menduno as applied to claim 1 above, and further in view of Bennahum, David "docs for Docs"(hereinafter Med-e-systems).

As to claim 6, ParkStone and Menduno do not explicitly disclose a method according to claim 1, wherein said method further comprises the initial step of distributing said electronic device, at a subsidized or no cost, to medical personnel.

However, Med-e-systems discloses the initial step of distributing said electronic device, at

a subsidized or no cost, to medical personnel (i.e.)(page 3). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the step of selling sponsorship rights to said sponsoring entity, wherein said sponsorship rights at least partly fund said medical data distribution system as disclosed by Med-e-systems within the ParkStone and Menduno combination for the motivation of encouraging physicians to use the medical data distribution system to prescribe cheaper brands of medication (page 4).

As to claim 7, ParkStone does not explicitly disclose a method according to claim 6, wherein said distributing step comprises lending a handheld computing device to a physician, where said handheld computing device is subsidized by said sponsoring entities.

However, Med-e-systems discloses the initial step of distributing said electronic device, at a subsidized or no cost, to medical personnel (i.e. insurance companies, will provide doctors with PDA's)(page 4). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include said distributing step comprises lending a handheld computing device to a physician, where said handheld computing device is subsidized by said sponsoring entities as disclosed by Med-e-systems within the ParkStone and Menduno combination for the motivation of encouraging physicians to use the medical data distribution system to prescribe cheaper brands of medication (page 4).

As to claim 11, ParkStone and Menduno do not explicitly disclose a method according to claim 1, wherein said communicating step further comprises the step of downloading executable instructions to the electronic device, wherein said executable instructions are capable of running

on the electronic device.

However, Med-e-systems discloses said communicating step further comprises the step of downloading executable instructions to the electronic device, wherein said executable instructions are capable of running on the electronic device (page 4). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include said communicating step further comprises the step of downloading executable instructions to the electronic device, wherein said executable instructions are capable of running on the electronic device as disclosed by med-e-systems within the ParkStone and Menduno combination for the motivation of encouraging physicians to use the medical data distribution system to prescribe cheaper brands of medication (page 4).

10. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over ParkStone and Menduno as applied to claim 1 above, and further in view of Examiner's use of Official Notice.

As to claim 8, ParkStone and Menduno do not explicitly disclose a method according to claim 1, wherein said method further comprises the step of placing indicia of the sponsored entity on said electronic device.

However, the Examiner takes official notice that it was well known in the electronic arts to place an indicia of a sponsoring entity on an electronic device. For example, cellular phone companies provide cellular phone service to customers. Oftentimes, cellular phone companies provide rebates or reduced prices on cellular phones manufactured by other companies in conjunction with introductory cellular phone service. The telephone, in addition to having an

indicia of the manufacturer, also contains an indicia of the cellular phone company. The purpose of the indicia is to draw the customer's attention to the cellular phone service provider identity. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the step of placing indicia of the sponsored entity on said electronic device within the ParkStone and Menduno combination for the motivation stated above.

11. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over ParkStone and Menduno as applied to claim 1 above, and further in view of "Medical Technology Start-Up Provides Medical Professionals with Mobile Point of Care Automation"(hereinafter med-I-nets).

As to claim 9, ParkStone and Menduno do not explicitly disclose a method according to claim 1, wherein said communicating step further comprises the steps of:
receiving a request for medical data from said electronic device; and
responding to the request by sending at least a portion of said medical data to said electronic device.

However, med-I-nets discloses receiving a request for medical data from said electronic device (i.e. using a palm-top computer and secure Internet connection, pharm-I-net(R) will immediately check for both drug interactions and insurance formularies in real time)(page 2). In addition, med-I-nets discloses responding to the request by sending at least a portion of said medical data to said electronic device (i.e. using a palm-top computer and secure Internet connection, pharm-I-net(R) will immediately check for both drug interactions and insurance formularies in real time)(page 2). It would have been obvious to one of ordinary skill in the art at

the time of Applicant's invention to include receiving a request for medical data from said electronic device; and responding to the request by sending at least a portion of said medical data to said electronic device as disclosed by med-I-nets within the ParkStone and Menduno combination for the motivation of decreasing the chance of prescribing dangerous prescriptions and reducing the cost and time of writing prescriptions (page 2).

12. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over ParkStone and Menduno as applied to claim 1 above, and further in view of Mayaud.

As to claim 10, ParkStone and Menduno do not explicitly disclose a method according to claim 1, wherein said communicating step further comprises the steps of:

sending a query to said electronic device; and

receiving a response to the query from said electronic device, where the response is determined by a choice made by medical personnel when presented with the query.

However, Mayaud discloses sending a query to said electronic device (i.e. preliminary selection of patients can be made by providing various patient lists ... such patient lists are preferably system maintained ...)(col. 17, lines 3-20). Furthermore, Mayaud discloses receiving a response to the query from said electronic device, where the response is determined by a choice made by medical personnel when presented with the query (i.e. ...enable the user to select a convenient group of patients ...)(col. 17, lines 3-20). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include sending a query to said electronic device and receiving a response to the query from said electronic device, where the

response is determined by a choice made by medical personnel when presented with the query as disclosed by Mayaud within the ParkStone and Menduno for the motivation of speeding access and retrieval of desired records (col. 17, lines 9-12).

13. Claims 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over ParkStone and Menduno as applied to claim 12 above, and further in view of Mayaud.

As to claim 14, ParkStone does not explicitly disclose a computer readable memory according to claim 12, wherein said aggregating instructions comprise instructions for collecting medical data selected from a group consisting of formulary and pharmacopeia data.

However, ParkStone discloses collecting medical data including formulary data (i.e. if a prescription formulary is changed or a new sub specialist is added to the provider panel, the PPARIS system enables the primary care provider to be aware of this new data ...)(page 2). Furthermore, Mayaud discloses collecting medical data from the group consisting of pharmacopeia data (i.e. test trials ... drug disclosure requirements as set forth by the FDA ... drug warnings and alerts ... cost benefit data ...adverse outcomes ... offer a selection of all known formulations of the drug selected)(col. 23, col. 24 and col. 26, lines 11-20). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include said aggregating instructions comprise instructions for collecting medical data selected from a group consisting of formulary data and pharmacopeia data as disclosed by Mayaud within the ParkStone and Menduno combination for the motivation of enabling a physician to rapidly quantify prescription information with appropriate dosages that can be filled at a pharmacy (col. 26, lines

11-15).

As to claim 16, ParkStone and Menduno do not explicitly disclose a computer readable memory according to claim 12, further comprising:
instructions for sending a query to said electronic device; and
instructions for receiving a response to the query from said electronic device, where the response is determined by a choice made by medical personnel when presented with the query.

However, Mayaud discloses instructions for sending a query to said electronic device (i.e. preliminary selection of patients can be made by providing various patient lists ... such patient lists are preferably system maintained ...)(col. 17, lines 3-20). Furthermore, Mayaud discloses instructions for receiving a response to the query from said electronic device, where the response is determined by a choice made by medical personnel when presented with the query (i.e. ...enable the user to select a convenient group of patients ...)(col. 17, lines 3-20). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include instructions for sending a query to said electronic device and instructions for receiving a response to the query from said electronic device, where the response is determined by a choice made by medical personnel when presented with the query as disclosed by Mayaud within the ParkStone and Menduno for the motivation of speeding access and retrieval of desired records (col. 17, lines 9-12).

14. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over ParkStone and Menduno as applied to claim 12 above, and further in view of med-I-nets.

As to claim 15, ParkStone and Menduno do not explicitly disclose a computer readable memory according to claim 12, further comprising:
instructions for receiving a request for medical data from said electronic device; and
instructions for responding to the request by sending at least a portion of said medical data to said electronic device.

However, med-I-nets discloses receiving a request for medical data from said electronic device (i.e. using a palm-top computer and secure Internet connection, pharm-I-net(R) will immediately check for both drug interactions and insurance formularies in real time)(page 2). In addition, med-I-nets discloses responding to the request by sending at least a portion of said medical data to said electronic device (i.e. using a palm-top computer and secure Internet connection, pharm-I-net(R) will immediately check for both drug interactions and insurance formularies in real time)(page 2). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include instructions for receiving a request for medical data from said electronic device; and instructions for responding to the request by sending at least a portion of said medical data to said electronic device as disclosed by med-I-nets within the ParkStone and Menduno combination for the motivation of decreasing the chance of prescribing dangerous prescriptions and reducing the cost and time of writing prescriptions (page 2).

15. Claims 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over ParkStone and med-I-nets.

As to claim 17, ParkStone discloses a computer readable memory storing executable

instructions for execution by a handheld computer system such that said handheld computer system functions in a specified manner (i.e. PPARIS ... a portable electronic prescription pad ... using proprietary software that runs on a Windows CE platform)(see abstract), said instructions comprising:

instructions for accessing a list of health care insurance plans (i.e. Windows CE-based support tool that enables physicians to have near real-time information on individual company guidelines)(page 2); and

instructions for automatically determining and displaying the status of a particular pharmaceutical relative to a particular health care insurance plan's formulary list (i.e. the physician is made aware of its formulary availability)(pages 2-3).

ParkStone does not explicitly disclose

where each of said health care insurance plans include an associated formulary list.

However, med-I-nets discloses where each of said health care insurance plans include an associated formulary list (i.e. pharm-I-net(R) will immediately check ... insurance formularies in real time)(page 2). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include where each of said health care insurance plans include an associated formulary list as disclosed by med-I-nets within ParkStone for the motivation of decreasing the chance of prescribing problematic or dangerous prescriptions (page 2).

As to claim 19, ParkStone discloses the computer readable memory of claim 17, wherein said instructions further comprise instructions for accessing and displaying data selected from a group consisting of lab results, pathology reports, x-ray reports, medical records, reference data,

billing codes, electronic prescription information, charge capture information, pregnancy information, or lactation information (i.e. ...clinical test database ... hospital charge tracking ... and data collected for clinical research studies)(page 2).

16. Claims 18 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over ParkStone and med-I-nets as applied to claim 17 above, and further in view of Mayaud.

As to claim 18, ParkStone and Menduno do not explicitly disclose the computer readable memory of claim 17, wherein said instructions further comprise instructions for accessing and displaying data concerning characteristics of said particular pharmaceutical selected from a group consisting of: clinical data, pharmacopeia type information, dosing information, co-payment information, pricing, adverse reaction information, drug-drug reaction information, contra-indication information, metabolism or excretion information, Drug Enforcement Agency schedules or drug trial information or criteria.

However, Mayaud discloses accessing and displaying data concerning characteristics of said particular pharmaceutical selected from the group consisting of clinical data, pharmacopeia type information, dosing information, co-payment information, pricing, adverse reaction information, drug-drug reaction information, contra-indication information, metabolism or excretion information, Drug Enforcement Agency schedules or drug trial information or criteria(i.e. test trials ... drug disclosure requirements as set forth by the FDA ... drug warnings and alerts ... cost benefit data ...adverse outcomes ... offer a selection of all known formulations of the drug selected)(col. 23, col. 24 and col. 26, lines 11-20). It would have been obvious to one of

ordinary skill in the art at the time of Applicant's invention to include instructions for accessing and displaying data concerning characteristics of said particular pharmaceutical selected from a group consisting of: clinical data, pharmacopeia type information, dosing information, co-payment information, pricing, adverse reaction information, drug-drug reaction information, contra-indication information, metabolism or excretion information, Drug Enforcement Agency schedules or drug trial information or criteria as disclosed by Mayaud within the ParkStone and Menduno combination for the motivation of enabling a physician to rapidly quantify prescription information with appropriate dosages that can be filled at a pharmacy (col. 26, lines 11-15).

As to claim 21, ParkStone and Menduno do not explicitly disclose the computer readable memory of claim 17, wherein said instructions further comprise:

instructions for receiving a query from a server;
instructions for displaying said query;
instructions for receiving a response to said query; and
instructions for transmitting said response to said server.

However, Mayaud discloses instructions for receiving a query from a server and instructions for displaying said query (i.e. a condition specific formulary drug list is displayed ...)(col. 35, lines 33-43). Furthermore, Mayaud discloses instructions for receiving a response to said query and instructions for transmitting said response to said server (i.e. ...none of the formulary drugs are suitable, then the physician can select Other, which selection displays a non-formulary list)(col. 36, lines 32-38). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include sending a query to said electronic device and

receiving a response to the query from said electronic device, where the response is determined by a choice made by medical personnel when presented with the query as disclosed by Mayaud within the ParkStone and Menduno for the motivation of improving the quality of prescriptions written (col. 4, lines 22-30).

17. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over ParkStone and med-I-nets as applied to claim 17 above, and further in view of Menduno.

As to claim 20, ParkStone does not explicitly disclose the computer readable memory of claim 17, wherein said instructions further comprise an instruction set for searching said database.

However, Menduno discloses said instructions further comprise an instruction set for searching said database (i.e. the system stores patients' drug usage in a central database and alerts doctors to potential adverse drug reactions at the time a prescription is written)(page 3). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include said instructions further comprise an instruction set for searching said database as disclosed by Menduno within ParkStone for the motivation of reducing adverse reactions to prescribed drugs (page 3).

18. Claims 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayaud in view of ParkStone and Menduno.

As to claim 22, Mayaud discloses an information management system for delivering data

to physicians (i.e. electronic prescription creation system for physician use)(see abstract), said system comprising:

a data processor (Fig. 16, unit 206);

a communication interface for communicating with at least one handheld computing device, where said communication interface is coupled to said data processor (i.e. communication hub 204 connected to data processor 206 and user interface devices (PDA) 200)(see Fig. 16 and col. 45, lines 18-29));

a database of aggregated pharmacopeia and formulary information further coupled to the data processor (i.e. drug formularies and drug and condition lists and some drug information maintained at host computer 206 or preferably refreshed from remote databases ... drug pharmacopeia information can be retrieved from remote databases)(col. 47, lines 30-57); and a memory coupled to the data processor, the memory storing instructions for execution by the data processor (col. 53, line 54 - col. 54, line 3); the stored instructions comprising:

instructions for storing medical data in a database (i.e. drug information maintained on the host computer facility)(col. 47, lines 47-51)

Mayaud does not explicitly disclose

instructions for periodically communicating selected medical data between said database and an electronic device to establish a medical data distribution system.

However, ParkStone discloses instructions for periodically communicating selected medical data between said database and an electronic device to establish a medical data distribution system (i.e. if a prescription formulary is changed ... the PPARIS system enables the primary care provider to be aware of this new data by the following day)(page 2). It would have

been obvious to one of ordinary skill in the art at the time of Applicant's invention to include instructions for periodically communicating selected medical data between said database and an electronic device to establish a medical data distribution system as disclosed by ParkStone within the Mayaud system for the motivation of providing assistance to physicians in keeping track of drug formularies (page 2).

Mayaud and ParkStone do not explicitly disclose a medical data distribution system subsidized by sponsoring entities.

However, Menduno discloses a medical data distribution system subsidized by sponsoring entities (i.e. Microsoft and Dupont ... agreed to underwrite prepaid subscriptions to Healtheon's Internet Service)(page 4). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include a medical data distribution system subsidized by sponsoring entities as disclosed by Menduno within the Mayaud and ParkStone combination for the motivation of increasing sponsor access to doctors and health care consumers (page 4).

As to claim 23, Mayaud discloses an information management system according to claim 22, wherein said instructions further comprises instructions for aggregating said medical data from multiple sources (i.e. drug information can be retrieved from remote databases)(col. 47, lines 47-57).

As to claim 24, Mayaud discloses an information management system according to claim 22, wherein said instructions further comprise instructions for collecting medical data selected from a group consisting of formulary and pharmacopeia data (i.e. formulary guidelines ...

pharmacopeia information)(col. 47, lines 41-53).

As to claim 25, Mayaud discloses an information management system according to claim 22, wherein said instructions further comprise:
instructions for receiving a request for medical data from said electronic device (i.e. selection program provides a variety of pathways for direct drug selection via five drug lists)(col. 38, lines 27-33); and instructions for responding to the request by sending at least a portion of said medical data to said electronic device (i.e. the system has displayed a portion of a long scrollable list of drugs)(col. 38, lines 27-33).

As to claim 26, Mayaud discloses an information management system according to claim 22, wherein said instructions further comprise:
instructions for sending a query to said electronic device; (i.e. preliminary selection of patients can be made by providing various patient lists ... such patient lists are preferably system maintained ...)(col. 17, lines 3-20) and
instructions for receiving a response to the query from said electronic device, where the response is determined by a choice made by medical personnel when presented with the query (i.e. ...enable the user to select a convenient group of patients ...)(col. 17, lines 3-20).

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Kalinowski, whose telephone number is (703) 305-2398. The examiner can normally be reached on Monday to Thursday from 6:30 AM to 4:00 PM. In addition, the examiner can be reached on alternate Fridays.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached on (703) 305-9588. The fax telephone number for this group is (703) 305-7687 (for official communications including After Final communications labeled "Box AF").

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th Floor, receptionist.



Alexander Kalinowski

Patent Examiner

Art Unit 3626

6/16/2003